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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,355	01/23/2004	Ravi Murthy	OI7035852001	2458
23639 7590 09/06/2007 BINGHAM MCCUTCHEN LLP Three Embarcadero Center San Francisco, CA 94111-4067			EXAMINER LEWIS, CHERYL RENE A	
			ART UNIT 2167	PAPER NUMBER
			MAIL DATE 09/06/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/763,355

Applicant(s)

MURTHY ET AL.

Examiner

Cheryl Lewis

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the applicants' amendment received on June 11, 2007. The Examiner acknowledges the applicants' ***Request for Continued Examination*** under 37 CFR 1.114 received on June 11, 2007.
2. Claims 1-50 are presented for examination.
3. The applicants have amended claims 1, 13, 22, 35, and 45-50. The applicants have not cancelled nor have the applicants added any new claims.
4. Applicants' arguments with respect to claims 1-50 have been considered but are deemed to be moot in view of the new grounds or rejection.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5, 6, 17, and 18 recite the limitation "path information". However, independent claims 1 and 13 recite the limitation "path string". Independent claims 1 and 13 do not make any reference to "path information".

For instance, independent claims 1 and 13 make reference to "hierarchical information" and this "hierarchical information" is further supported in dependent claims 2 and 14. Therefore, dependent claims 5, 6, 17, and 18 have insufficient antecedent basis because these claims are dependent on independent claims 1 and 13, wherein claims 1 and 13 recite "path string" and not a recitation for "path information".

There is insufficient antecedent basis for this limitation in the claim.

7. Claims 38 and 40 recite the limitation "one or more indexes comprise an index". However, dependent claim 38 is depends on dependent claim 37 and dependent claim 40 is depends on dependent claim 39. Dependent claims 37 and 39 do not make reference to limitations having "one or more indexes".

There is insufficient antecedent basis for this limitation in the claim.

Claim Objections

8. Claims 1, 13, 22, 35, and 45-50 are objected to because of the following informalities:

Claim 1 is objected to because the claim limitations do not specifically recite any manipulation and/or a transformation in the claim limitations that would produce a tangible result. Although, the limitations begin with parsing the XML document to identify a node, the node is then identified in the XML document and later stored. However, dependent claims 6-9 include limitations that include the manipulation and/or a transformation in the path that would produce a tangible result. Dependent claims 6-9 include an "entry" in the path that details how the claim limitation is being manipulated.

The Examiner kindly requests that the applicants consider amending independent claim 1 to include the limitations of dependent claims 6-9. Including dependent claims 6-9 into independent claim 1 would give independent claim 1 tangible results.

Likewise, the Examiner recommends the same changes for independent claim 13 (including limitations from dependent claims 6-9).

For independent claim 22, the Examiner recommends including limitations from dependent claims 27 and 28.

For independent claim 35, the Examiner recommends including limitations from dependent claims 41 and 44.

For independent claims 45-47, the Examiner recommends including limitations from dependent claims 6-9.

For independent claims 48, the Examiner recommends including limitations from dependent claims 27 and 28.

For independent claims 49 and 50, the Examiner recommends including limitations from dependent claims 41 and 44.

The remaining claims are dependent claims. These claims are also objected to for being dependent on the above objected to independent claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 45, 47, and 49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As follows:

Claims 45, 47, and 49 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 45, 47, and 49 are directed to software claims. These claims comprise a computer program product comprising a computer usable medium.

In the disclosure of the applicants' published document, publication no. 20050055355, at ¶ [0084], media is described as a carrier wave, electromagnetic waves, etc.

Therefore, the applicants' claim limitation reciting "medium" is actually claiming a carrier wave, electromagnetic waves, etc.

The Examiner kindly recommends that the applicants' consider amending the limitations of claims 45, 47, and 49 to recite "...a computer storage medium..."

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive

material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

Therefore, the remaining claims are dependent claims which are dependent upon the above rejected independent claims. These claims are also rejected for at least the reasons set forth above.

NAME OF CONTACT

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Lewis whose telephone number is (571) 272-4113. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cottingham can be reached on (571) 272-7079. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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(571) 273-4113 (Use this FAX #, only after approval by Examiner, for "INFORMAL" or "DRAFT" communication. Examiners may request that a formal paper/amendment be faxed directly to them on occasions.).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist/ Technology Center (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Cheryl Lewis/
Patent Examiner, A.U. 2167
August 29, 2007